

REMARKS/ARGUMENTS

Reconsideration of this application is requested. Claims 1-24 are pending in the application of these claims 1-14 and 20-24 are under active examination while the remaining claims 15-19 have been withdrawn from consideration as directed to non-elected subject matter. While applicants believe that the requirement for restriction is inappropriate they will proceed with the examination of claims 1-14 and 20-24.

In item 4 of the Official Action claim 2 is objected to as failing to further limit the subject matter of the previous claim, claim 1. That is not the case. Claim 1 specifies a substrate, a first film and a second film. Claim 1 does not specify whether the first film or the second film is in contact with the substrate. That is the function of claim 2. As such, claim 2 further limits claim 1 and is an appropriate dependent claim. Reconsideration and withdrawal of the objection is requested.

Elected claims 1-14 and 20-24 are rejected under 35 USC §103(a) as being unpatentable/"obvious" over U.S. patent 6,858,606 to Strickler. Applicants traverse.

The examiner has failed to establish a *prima facie* case of obviousness and apparently has fallen into a position that is based upon hindsight reconstruction of the prior art. To establish a case of *prima facie* obviousness, all of the claim limitations must be taught or suggested by the prior art. *See* M.P.E.P. § 2143.03. A claimed invention is unpatentable if the differences between it and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. *In re Kahn*, 78 USPQ2d 1329, 1334 (Fed. Cir. 2006) citing the legal standard provided in *Graham v. John Deere*, 148 USPQ 459 (1966). The *Graham* analysis needs to be made explicitly. *KSR v. Teleflex*, 82 USPQ2d 1385, 1396 (2007). It requires findings of fact and a rational basis for combining the prior art disclosures to produce the claimed invention. *See id.* ("Often, it will be necessary for a court to look to interrelated teachings of multiple patents . . . and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue"). **The use of hindsight reasoning is impermissible.** *See id.* at 1397 ("A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning"). Thus, a *prima facie* case of obviousness under Section 103(a)

requires “some rationale, articulation, or reasoned basis to explain why the conclusion of obviousness is correct.” *Kahn*, 78 USPQ2d at 1335; *see KSR*, 82 USPQ2d at 1396. ... A determination of *prima facie* obviousness requires a reasonable expectation of success. *See In re Rinehart*, 189 USPQ 143, 148 (C.C.P.A. 1976).

As is acknowledged on page 5, first full paragraph of the Action, Strickler et al do not disclose a concentration of the fluorine dopant other than that it should be sufficient to provide an emittance of less than 0.2 (column 4, lines 19-20). According to the examiner the skilled person would vary the composition of the layers in order to optimize the color of the coated glass (column 5, lines 9-12) and thereby arrive at a coating according to the present invention.

However, this reasoning is based on hindsight.

Strickler et al teach a coating which provides a glass article with a color neutral reflectance, a low emittance, a high visible light transmittance, and a low total solar energy transmittance. Strickler et al do *not* disclose or suggest any *difference* in doping concentration between the antimony doped layer and the fluorine doped layer.

The coating of the present invention comprises a first and a second film of transparent conducting oxide with electron donor on top of each other, where the second film comprises relatively at least 10% less electron donor than the first film. This provides excellent electrical conductivity in combination with an optimal surface morphology.

Based on the teachings of Strickler et al the skilled person would have no expectation of success in achieving these advantageous effects, because Strickler et al do not suggest using a difference in dopant concentration. More in particular, Strickler et al fail to teach or suggest using a difference in electron donor concentration of at least 10%. In addition, Strickler et al fail to teach or suggest using a higher concentration of electron donor in the layer closest to the substrate.

It follows from the above that the present invention is not obvious in view of Strickler et al.

Withdrawal of the Section 103 rejection is requested because the claimed invention would not have been obvious to the ordinarily skilled artisan at the time Applicants made their invention.

ZIJP et al.

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Having responded to all of the pending rejections contained in the Office Action, Applicants submit that the claims are in condition for allowance and earnestly solicit an early Notice to that effect. The Examiner is invited to contact the undersigned if any further information is required.

Respectfully submitted,

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